

U.S. Application No. 09/942,672
Client/Matter: 016795-0282906

REMARKS

I. Status of the claims

Claims 1, 2, 4-19, 20-22, and 24-28 are pending. Claims 19 and 23 have been cancelled. Claims 1, 20-22, and 24 have been amended. In particular, claims 1 and 21 have been amended to recite a preferred formulation that is free of water. Support for this amendment may be found in the formulations disclosed in Examples 1-3 of the specification, all of which were prepared without any water. Claims 20 and 22 were amended to include additional preferred components in the composition, and claims 22 and 24 were amended to focus the application of the method on the hairy area of the scalp. Claims 26-28 have been added as new claims dependent on method claims 20-22. The new claims recite the preferred topical anesthetic and solubilizer recited in original claims 4 and 6. No new matter has been added through these amendments or new claims.

II. Rejections over Jackson

The examiner has rejected claims 22-25 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,461,644 to Jackson et al. ("Jackson"), and the examiner has rejected claim 20 under 35 U.S.C. § 103(a) as being unpatentable over Jackson. The examiner states that Jackson teaches anesthetizing polymer system that include the polymer PVC and a topical anesthetic that can be used as transdermal patches for providing an anesthetizing effect on the skin. With respect to claim 20, the examiner states that while Jackson does not teach applying the anesthetizing polymer system to the scalp, one of ordinary skill would have been motivated to modify the anesthetizing method of Jackson to use it for hair removal from the scalp. Applicants respectfully traverse these rejections.

Applicants have amended claims 20 and 22 to recite that the composition includes a solubilizer and at least one plant extract oil in addition to the topical anesthetic and polymer. Jackson does not teach a method of using a composition that contains a solubilizer for solubilizing the topical anesthetic or a plant extract oil. Instead, Jackson focuses on administering the anesthetic by incorporating it with a suitable wall polymer that meets three selection criteria. Jackson lists polyvinyl chloride and vinyl urethane copolymer as two of the

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preferred wall polymers. See paragraph 2, lines 24-59. There is no disclosure in Jackson relating to solublizers or plant extract oils, nor is there any suggestion from the disclosure of Jackson that adding such components would facilitate the drug delivery polymer system described in Jackson. Therefore, Jackson neither teaches nor suggests all elements of the composition recited in method claims 20 and 22.

Moreover, Jackson does not teach or suggest a method of desensitizing a scalp, particularly a scalp having hair, as recited by Applicants in claims 20 and 22. As discussed above, Jackson discloses applying the anesthetic polymer system through a transdermal patch. However, there is no suggestion that a transdermal patch, typically applied to the skin, could be effective when applied to the scalp. In fact, logical suggests that the hair on one's scalp would prevent, or at least substantially impair, the effectiveness of any type of transdermal or polymer drug delivery application on the scalp. Therefore, the methods disclosed in Jackson do not teach or suggest the methods recited in claims 20 and 22 of Applicants' invention.

Accordingly, Applicants respectfully request that the examiner withdraw the rejection of claims 22-25 and the rejection of claim 21 based on Jackson.

III. Rejection over Kaplan and Smith

The examiner has rejected claims 1, 2, 4-19 and 21 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,052,513 to Kaplan ("Kaplan") in view of U.S. Patent No. 5,874,074 to Smith ("Smith").

Applicants have amended claims 1 and 21 to recite formulations that are free of water. In contrast to Applicants' claims, both Kaplan and Smith disclose oil-in-water emulsions that use significant amounts of waters. Kaplan discloses that the composition contains 30-90 percent water, preferably 40-70 percent. See column 2, lines 31-35. Similarly, Smith discloses that the formulations contain 50-90 percent water. See col. 6, lines 49-59.

Because Kaplan and Smith relate to oil-in-water emulsions containing significant amounts of water, neither reference, alone or in combination, teaches or suggests Applicants' claims reciting formulations that are free of water. Accordingly, Applicants respectfully request that the examiner withdraw the rejection of claims 1, 2, 4-19 and 21 based on Kaplan and Smith.

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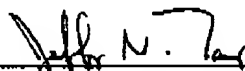
IV. Conclusion

If any issues in this application remain unresolved, the examiner is encouraged to contact the undersigned counsel at the number listed below in order to resolve such issues.

Please charge any fees associated with the submission of this paper to Deposit Account No. 03-3975. The Director is also authorized to credit any overpayments to the above-referenced Deposit Account.

Respectfully submitted,

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